



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/552,262

04/19/2000

Jerry Dunietz

03797.87364

4106

28319

7590

03/10/2006

BANNER & WITCOFF LTD.,
ATTORNEYS FOR MICROSOFT
1001 G STREET, N.W.
Suite 1100
WASHINGTON, DC 20001-4597

EXAMINER

SMITH, PETER J

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/552,262	Applicant(s) DUNIETZ ET AL.	
	Examiner Peter J. Smith	Art Unit 2176	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-35.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☐ Other: _____.

[Signature]
 Dough Hutton
 Primary Examiner
 Tech Center 2100

Continuation of 11. does NOT place the application in condition for allowance because: Regarding Applicant's argument in pages 7 and 8 that the combination of Tada and Fontaine fails to teach separating the tag from the content with a separation variable, as defined in claim 1, the Examiner respectfully disagrees. The Examiner believes Fontaine teaches inserting a separation variable within the broadest reasonable interpretation of the claimed separation variable in col. 4 line 31 – col. 5 line 44 and col. 5 line 60 – col. 6 line 35. Fontaine demonstrates the use of the %% symbols in col. 4 lines 49-55. These are variable characters and they are separating the tag from the content, and therefore reads upon the "separation variable" under the broadest reasonable interpretation.

Regarding Applicant's argument in page 9 that the combination of Tada and Fontaine does not teach each replacing the tag with an alias, wherein the alias is a pre-defined representation for the tag, the Examiner respectfully disagrees. Tada teaches a control code, which reads upon the claimed alias in col. 22 lines 6-20. Tada uses that the control, or alias, to replace the corresponding tag. Since the control code is corresponding to the tag, it is a pre-defined representation. Therefore, the Examiner maintains that the combination of Tada and Fontaine teaches replacing the tag with an alias, under the broadest reasonable interpretation.

Regarding Applicant's argument in pages 9 and 10 that the combination of Tada and Fontaine does not teach inserting at least one flag within the tag to form an encode tag structure, the Examiner respectfully disagrees. The Examiner believes the encode tag structure is taught by Tada from the combination of the separation variable of Fontaine and the alias and control of Tada. Therefore, in combination an encode structure is taught and therefore the Examiner maintains that the combination of Tada and Fontaine teaches the encode tag structure under the broadest reasonable interpretation.

Regarding Applicant's argument in page 10 that the combination of Tada and Fontaine is not proper, the Examiner respectfully disagrees. Both Tada and Fontaine are directed to improvements in electronic document manipulation and therefore would have been known to one of ordinary skill in the art at the time of the invention. Therefore, it would have been obvious to have combined the advantages of Tada and Fontaine to have improved the structure of the electronic documents.

Regarding Applicant's argument in pages 11 and 12 that Tada and Fontaine do not teach inserting at least one code character into the electronic document to separate markup language from content, as defined in claim 16, the Examiner respectfully disagrees. The Examiner believes Fontaine teaches inserting a code character within the broadest reasonable interpretation of the claimed code character in col. 4 line 31 – col. 5 line 44 and col. 5 line 60 – col. 6 line 35. Fontaine demonstrates the use of the %% symbols in col. 4 lines 49-55. These are code characters and they are separating the tag from the content, and therefore reads upon the "code character" under the broadest reasonable interpretation.

Regarding Applicant's argument in pages 12 and 13 that the combination of Tada and Fontaine does not teach a tag having encoded therein a predefined integer alias for the tag, as defined in claim 19, the Examiner respectfully disagrees. Tada teaches a control code, which reads upon the claimed alias in col. 22 lines 6-20. Tada uses that the control, or alias, to replace the corresponding tag. Since the control code is corresponding to the tag, it is a pre-defined representation. Therefore, the Examiner maintains that the combination of Tada and Fontaine teaches replacing the tag with an alias, under the broadest reasonable interpretation.

Regarding Applicant's argument in page 13 that the combination of Tada and Fontaine does not teach a code separating the tag from the content portion, whereby the content and markup within the document may be readily parsed at run-time, as defined in claim 19, the Examiner respectfully disagrees. The Examiner believes Fontaine teaches inserting a code character within the broadest reasonable interpretation of the claimed code character in col. 4 line 31 – col. 5 line 44 and col. 5 line 60 – col. 6 line 35. Fontaine demonstrates the use of the %% symbols in col. 4 lines 49-55. These are code characters and they are separating the tag from the content, and therefore reads upon the "code character" under the broadest reasonable interpretation.

Regarding Applicant's argument in pages 13 and 14 that Tada and Carus do not teach or suggest determining whether the tag is within a single word, as defined in claim 10, the Examiner respectfully disagrees. The Examiner believes that the combination of Tada and Carus suggests this feature. Tada teaches identifying tags in a document in col. 1 lines 7-13, col. 21 lines 50-64, and col. 22 lines 6-20. Carus teaches comparing a left and right term to determine if they are part of a single word and if they left and right terms are not part of a single word, inserting a word break flag between the left and right terms in col. 2 line 62 – col. 3 line 31 and col. 5 lines 51-67. Therefore, in combination, Tada and Carus teach the limitation of determining whether a tag is within a single word.

Regarding Applicant's argument in page 14 that Tada does not teach or suggest the limitation of if the portion is not to be displayed for viewing, inserting a no search flag in association with the portion, whereby a no search field may be readily identified and skipped during a run-time linear search, as defined in claim 12, the Examiner respectfully disagrees. The Examiner maintains that the coded identification number described in col. 22 line 24 – col. 23 line 24 determines whether the text should be searched or not.

Regarding Applicant's argument in pages 14 and 15 that Tada does not suggest that the no search flag is conditionally inserted based on determining whether the portion is to be displayed for viewing by a reading device, the Examiner respectfully disagrees. The Examiner believes Tada suggests implementing a conditional no search in col. 6 line 30 – col. 7 line 20.

Regarding Applicant's argument in page 15 that Open eBook does not teach or suggest replacing part of the URL with the reference string and a flag from the file, as defined in claim 14, the Examiner respectfully disagrees. The Examiner notes that Open eBook teaches both a URL and a reference string in section 2.3 on page 18. Furthermore, Open eBook is partially based on HTML. It was known at the time of the invention to use HTML to replace part of a URL with a reference string. Therefore, the Examiner maintains the rejection of claims 14 and 15 as being obvious over Open eBook.

Regarding Applicant's argument in pages 15 and 16 that the combination of Open eBook and Tada does not teach or suggest wherein the content file is pre-computed and encoded to minimize computational run-time requirements, as defined in claim 24, the Examiner respectfully disagrees. Tada does teach a content file which is pre-computed and encoded to minimize run-time requirements in col. 1 lines 7-13, col. 21 lines 50-64, col. 22 lines 6-20, and col. 22 line 24 – col. 23 line 24. Tada teaches in col. 6 lines 30 – col. 7 line 20 the advantage of decreased search time as a result of pre-computing and encoding the content file. Therefore, in view of this advantage taught by Tada, it would have been obvious and desirable to have improved Open eBook with the teachings of Tada.

Regarding Applicant's argument in pages 16 and 17 that the combination of Open eBook and Tada does not teach forming a converted document, as defined in claim 32, the Examiner respectfully disagrees. Tada does teach converting a document in a first format by processing the document to pre-compute and encode the markup language within the document in col. 1 lines 7-13, col. 21 lines 50-64, col. 22 lines 6-20, and col. 22 line 24 – col. 23 line 24. Tada teaches an implementation on a computer readable medium

in fig. 1 and col. 11 line 39 – col. 12 line 5. Tada teaches in col. 6 lines 30 – col. 7 line 20 the advantage of decreased search time as a result of pre-computing and encoding the document into a converted document. Therefore, in view of this advantage taught by Tada, it would have been obvious and desirable to have improved Open eBook with the teachings of Tada such that the document of Open eBook is converted from a first format to a second format.